

REMARKS

Upon entry of the present amendment, claims 1, 4 and 19 will have been amended while claims 9, 18 and 21 will have been canceled. Additionally, claims 22-25 will have been submitted for consideration by the Examiner.

In view of the hereincontained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of each of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application.

Initially, Applicant wishes to make of record a telephone interview conducted between Applicant's undersigned representative William Pieprz and the Examiner in charge of the present application. Applicant would like to thank Examiner Vrettakos for his cooperation and consideration in scheduling and conducting the above-noted interview. Applicant's representative would further like to thank the Examiner for his positive and proactive approach towards the discussion as well as for his maintaining an open mind with respect to the various features recited in the claims and the explanation thereof, as described and discussed during the above-noted interview.

During the above-noted interview, Applicant's representative first questioned the Examiner regarding the status of claims 18 and 21 and of claims 16 and 17. Applicant noted that while these claims were indicated as rejected on the front page of the Official Action, as well as in the first paragraph thereof, they have not been included in any statements of the rejection and appear not to have been discussed in the Examiner's recitation of the features of various claims of the invention. In particular, although the Examiner appears to have individually treated each dependent claim in explaining the rejections, he has not treated claims 16-18 and 21.

In response to these queries, the Examiner indicated that each of these claims should be included in the primary rejection applied against the respective independent claims. In other words, the Examiner indicated that each of these three claims should be considered to be rejected under 35 U.S.C. § 103 as unpatentable over MARUCCI et al. (U.S. Patent No. 6,582,451) in view of SCHMALTZ et al. (U.S. Patent No. 6,050,996).

During the interview, Applicant's representative addressed the independent claims and asserted that contrary to the Examiner's assertion in the outstanding official rejection, the manipulation members do not comprise a pair of electrodes, as recited in claim 1. In this regard, Applicant noted that the Examiner, in setting forth the rejection, has asserted that MARUCCI et al. neglects to "expressly disclose the manipulating members comprising electrodes" but asserted that they nevertheless comprise a pair of electrodes, based upon column 6, lines 33-40 of MARUCCI et al. Applicant respectfully traversed the above position and submitted that, contrary to the Examiner's assertion, this portion of disclosure teaches just the opposite. In this regard, Applicant notes that the above-quoted paragraph of MARUCCI et al. merely discloses that the jaw members "may act as platforms for diagnostic or therapeutic modalities". Thus, it is clear from this portion of disclosure that the jaw members themselves are not the various enumerated "diagnostic or therapeutic modalities", but are platforms or supports for such modalities. In direct contrast, Applicant's claim 1 recites that the manipulation members comprise a pair of electrodes. This means that the manipulation members are the electrodes, not that they are platforms or supports for electrodes.

Additionally, during the above-noted interview, Applicant's representative pointed out numerous distinctions between the features of various claims and the MARUCCI et al. disclosure. Initially, Applicant's representative discussed the features of claims 18 and 21 which have previously been rejected by the Examiner under 35 U.S.C. § 112. In this regard, Applicant's representative pointed out that according to a feature of the present invention, the manipulation members are moved between the open and closed positions by leads that are connected to the high-frequency power supply. It was pointed out that this feature is not taught, disclosed nor rendered obvious by MARUCCI et al. Furthermore, it was pointed out that since MARUCCI et al. uses a single activation element (i.e., reciprocating rod 14), it would not be obvious therefrom to substitute individual leads connected to the manipulation members to move these members, as required by Applicant's claim.

During the above-noted discussion, Applicant's representative further discussed the recitation of claim 16 regarding the second shaft and claim 17 dependent thereon. Applicant's representative pointed out that the recitations of claims 16 and 17 are not taught, disclosed nor rendered obvious by any disclosure of MARUCCI et al.

With respect to independent claim 19, during the above-noted interview, Applicant noted that the recitation of a spacer fixedly positioned with respect to "said support member within said slit" is not taught, disclosed nor rendered obvious by MARUCCI et al. In this regard, Applicant first noted that according to the Examiner's interpretation of MARUCCI et al., the spacer comprises elements 24 and 25, which as clearly shown in Figs. 1A and 1B, are not fixedly positioned with respect the support member which is identified by the Examiner as element 11. Yet additionally, spacer

(24, 25) is also not fixedly positioned within the slit as clearly seen in Fig. 1B where of the linkage elements are shown to extend outside the slit.

During the above-noted interview, Applicant's undersigned representative also pointed out numerous other features of the present invention that are not taught, disclosed or rendered obvious by MARUCCI et al.

At the completion of the interview, the Examiner indicated that he now more fully comprehended the various asserted distinctions between MARUCCI et al. and the claims of the present invention. While Applicant's representative urged that independent claims 1 and 19 are clearly allowable over the references of record and while the Examiner acknowledged the asserted distinctions between the prior art and the recitations of the pending independent claims, the Examiner further indicated that to improve the chances for allowance of the application, the claims be amended to incorporate features, such as the recitations of claims 18 and 21, into the respective independent claims.

Thus, based on the Examiner's suggestion, Applicant has amended claims 1 and 19 to incorporate therein the features of claims 18 and 21, respectively. However, by so doing, Applicant does not in any way acquiesce in the propriety of the Examiner's rejection. Rather, Applicant is making the above-noted changes merely in order to expedite the allowance of the present application.

Together with the above-noted amendments to the claims, Applicant has submitted several additional claims for consideration by the Examiner. These claims recite features discussed during the above-noted interview and that the Examiner agreed are not disclosed by the references relied upon. Accordingly, these additional

dependent claims provide yet additional bases for patentability, in addition to the basis provided by their dependence from a shown to be allowable claim. These claims provide Applicant a scope of protection to which he is entitled.

At the conclusion of the interview, the Examiner indicated that the amendments must be reviewed by his supervisor but that he agreed that the features recited in various of the claims are clearly not disclosed by the references relied upon by the Examiner.

As noted above, Applicant respectfully thanks the Examiner for his cooperation and courtesy during the above-noted interview and thanks him for his assistance in expediting the prosecution of the present application and its ultimate issuance as a patent.

As noted above, Applicant has set forth various bases for the patentability of the claims in the present application and submits that the distinctions and differences between the references as applied by the Examiner and the pending claims have been pointed out and set forth with clarity and specificity, as required.

Moreover, in the above-noted rejection, the Examiner combined the teaching of SCHMALTZ et al. with those of MARUCCI et al. The Examiner asserted that SCHMALTZ et al. discloses analogous forceps with jaws manipulation members with RF electrodes. It is respectfully submitted that the Examiner is not correct in his characterization of the SCHMALTZ et al. device.

Initially, Applicant notes that contrary to the Examiner's assertion that SCHMALTZ et al. discloses analogous forceps, it is respectfully submitted that SCHMALTZ et al. merely discloses a bipolar electrosurgical instrument which is

manually manipulated and is not configured to be inserted into the human body through an endoscope as recited in each of Applicant's independent claims. For this reason alone, it is respectfully submitted that any combination of SCHMALTZ et al. and MARUCCI et al. would not be obvious to one of ordinary skill in the art.

Yet additionally, SCHMALTZ et al. merely discloses electrodes 11 and 12 which are removably mounted, respectively, in first and second sockets 22 and 23 which are located on the jaws 19 and 20. Thus, it is not the manipulation members, which the Examiner characterizes as 19 and 20, which comprise the electrodes, but rather the manipulation members are merely platforms to support the electrodes 11 and 12. Thus, while the teachings of SCHMALTZ et al. are somewhat more explicit and detailed than of MARUCCI et al., in fact the teachings thereof are not significantly better than that of MARUCCI et al. alone. Both MARUCCI et al. and SCHMALTZ et al. merely disclose members that support electrodes. For each of these reasons, it is respectfully submitted that, even if combined with MARUCCI et al., SCHMALTZ et al. would not overcome the shortcomings and deficiencies of MARUCCI et al., and the Examiner has set forth no motivation for combining the teachings of SCHMALTZ et al. and MARUCCI et al.

Regarding claims 8 and 12, it is respectfully submitted that the additional teachings of MAYENBERGER can also not overcome the shortcomings and deficiencies of MARUCCI et al., at least because the Examiner has not included SCHMALTZ et al. in this combination. Accordingly, at least because of the shortcomings acknowledged by the Examiner in the discussion of the rejection of the

independent claims, the rejection of claims 8 and 12 are submitted to be inadequate and insufficient to teach the features recited therein.

Additionally, the Examiner has relied upon the standard of "design expedient" for motivation. It is submitted that such reliance is incorrect. In particular, in order to provide a motivation for a proposed combination, the Examiner must find a teaching not only that the references can be combined, but a reason why they should be combined. The Examiner has not provided such a teaching from the prior art as is required, and for this additional reason, each of the Examiner's rejections is submitted to be insufficient.

Accordingly, Applicant respectfully requests consideration of the newly submitted and newly amended claims as well as an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has made of record an extensive telephone interview conducted with the Examiner in charge of the present application. Applicant has further discussed the various distinctions and differences pointed out during the above-noted interview between the features of Applicant's claims and disclosures of the references relied upon. Applicant has pointed out the shortcomings of the references with respect to the recitations of Applicant's claims. Applicant has also noted deficiencies of the disclosures of these references with respect to the claimed features of Applicant's invention. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully requests an indication to such effect, in due course.


Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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